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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/424,544	11/24/1999	MASUMITSU INO	SON-1582/SUG	8128

7590 07/21/2004
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 07/21/2004

27

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/424,544

Applicant(s)

INO ET AL.

Examiner

Jeff Piziali

Art Unit

2673

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 04 February 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 13 and 14.

Claim(s) rejected: 3,5-7,11,13-20,23-29,31,37 and 43-48.

Claim(s) withdrawn from consideration: _____.

8. ☒ The drawing correction filed on 04 February 2004 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____



BIPIN SHALWALA
SUPERVISORY PATENT EXAMINER



J.P.
19 July 2004

Continuation of 2. NOTE:

The proposed amendment filed 8 March 2004 (Paper No. 25), if entered, would cancel a total of 14 finally rejected claims (i.e. claims 3, 5, 7, 11, 13-20, 23, and 24) while presenting an additional 18 claims (i.e. claims 49-66).

Although the applicants divided this proposed amendment into two sections, labeled respectively "SECOND AMENDMENT AFTER FINAL OFFICE ACTION UNDER 37 C.F.R. 1.116" and "THIRD AMENDMENT AFTER FINAL OFFICE ACTION UNDER 37 C.F.R. 1.116," only one amendment paper was filed and paid for by the applicants — as evidenced by the single attached "AMENDMENT TRANSMITTAL LETTER" dated 8 March 2004.

The applicants are hereby notified that should "SECOND AMENDMENT AFTER FINAL" and "THIRD AMENDMENT AFTER FINAL" be submitted as two separate papers in the future, only the "SECOND AMENDMENT" will be considered for entry. The reasoning being that the "SECOND AMENDMENT" would cancel more finally rejected claims than it adds. While on the other hand, the "THIRD AMENDMENT" would present additional claims without canceling a corresponding number of finally rejected claims.

By such reasoning, nonentry of the proposed amendment is deemed necessary and proper at this time.

**Notification of Non-Compliance
With 37 CFR 1.192(c)**

Application No.

09/424,544

Applicant(s)

INO ET AL.

Examiner

Jeff Piziali

Art Unit

2673

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The Appeal Brief filed on 02 April 2004 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

To avoid dismissal of the appeal, applicant must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192(c) within the longest of any of the following three **TIME PERIODS**: (1) **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer; (2) **TWO MONTHS** from the date of the notice of appeal; or (3) within the period for reply to the action from which this appeal was taken. **EXTENSIONS OF THESE TIME PERIODS MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☐ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☐ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☐ A single ground of rejection has been applied to two or more claims in this application, and
 - (a) ☐ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
 - (b) ☐ the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☐ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☒ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

The "APPELLANT'S BRIEF" (Paper No. 26, filed 2 April 2004) presents a Claim Appendix (see Pages 14-17 of the Brief) that assumes entry of at least the proposed "SECOND AMENDMENT AFTER FINAL OFFICE ACTION UNDER 37 C.F.R. 1.116." However, as explained in the concurrently mailed Advisory Action (Paper No. 27), the proposed amendment (Paper No. 25, filed 8 March 2004), if entered, would cancel a total of 14 finally rejected claims (i.e. claims 3, 5, 7, 11, 13-20, 23, and 24) while presenting an additional 18 claims (i.e. claims 49-66). Therefore, nonentry of the proposed amendment is deemed necessary and proper at this time. And for such reason, the Brief does not contain a correct copy of the appealed claims as an appendix thereto.


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19 July 2004